makes clear at what stage of the process the step has to be performed and, therefore, restricts independent claim 8 to a process which is performed "prior to manufacture of enduse articles". Thus it distinguishes the inventive process from processes which are performed at other stages of fiber or fabric processing, such as processes performed with end articles, e.g. laundering soiled articles of apparel. It thus gives "life and meaning" to the claim.

It is therefore an error of fact and law to ignore the preamble limit.

The general rule for when the preamble gives "life and meaning" to the claims is set forth in *Kropa v. Robie*, 88 USPQ 478 (1951). It is the classic case on when the preamble is a claim limit. In *Kropa* the court surveyed 37 prior cases and stated at 480–81:

> [I]t appears that the preamble has been denied the effect of a limitation where the claim or count was drawn to a structure and the portion of the claim following the preamble was a self-contained description of the structure not depending for completeness upon the introductory clause * * *. In those cases, the claim or count apart from the introductory clause completely defined the subject matter, and the preamble merely stated a purpose or intended use of that subject matter. * * * in those * * * cases, where preamble * * * was expressly or by necessary implication given the effect of a limitation, introductory phrase was deemed essential to point out the invention * * *. In the latter class of cases, the preamble was considered necessary to give life, meaning and vitality to the claims.

More recently, in *Corning Glass Works v. Sumitomo Electric U.S.A. Inc.*, 9 USPQ 2d 1962, 1966 (CAFC, 1989) the court stated:

> No litmus test can be given with respect to when the introductory words of a claim, the preamble, constitute a statement of purpose for a device or are, in themselves, additional structural limitations of a claim. To say that a preamble is a limitation if it gives "meaning to the claim" may merely state the problem rather than lead one to the answer. The effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim. Here, the 915 specification makes clear that the inventors were working on the particular problem of an effective optical communication system not on general improvements in conventional optical fibers.

Here, the present specification makes clear that the inventors were working on the particular problem of an effective process for the pretreatment of fiber materials which is carried out while the fiber materials are still in the form of textile sheets, as a preparation for subsequent manufacturing steps such as dyeing, or in order to remove impurities like sizes or spinning finishes, and prior to manufacture of enduse articles from the sheets such as articles of clothing, not on general improvements in conventional laundering of textile garments.

This distinguishing feature is important since the requirements (for example primary wettability and rewettability) for a pretreatment process are quite different from the requirements for the Stringer and Gosselink processes, which are not pretreatment processes as defined in the specification, but are processes to be performed with end articles.

Applicants note that *In re Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985), cited by the examiner in support of her position, relates to an apparatus, not a process. An apparatus or a composition may be obvious for any purpose, but use of even a known composition in a different process may not be obvious. Here the composition is not known and the process is a different one from Stringer's.

As previously pointed out, Stringer discloses (see Summary of the Invention in column 4) aqueous solutions of an amine oxide which are used *inter alia* in "... cleaning compositions such as fabric care cleaning compositions ...". Obviously, the compositions of Stringer serve quite a different purpose than the inventive compositions because fabric care processes are performed upon textile end products, while the instant pretreatment process is performed on fiber materials in the form of textile sheets, as a preparation for subsequent manufacturing steps, in order to remove impurities like sizes or spinning finishes before dyeing or otherwise them, prior to manufacture of the end products from the sheets. Stringer has no teachings concerning such a process.

The Stringer reference generically discloses groups of compounds under which each of components A, B and C of instant process claim 8 fall. As noted by the examiner, Stringer discloses sodium cumene sulfonate (= a preferred component A). But nowhere does Stringer disclose, either in the specification or in Example 3, any mixture that contains all 3 of A, B and C, much less any mixture comprising these components in the amounts required by claims 7 or 13. Applicants aver that the light duty liquid cleaning formulation according to the table of Example 3, pointed to by the examiner,

does not contain component A in the amounts required by claims 7 or 13, and does not contain either component B or component C. This will be explained in more detail below.

Since the groups of compounds Stringer generically discloses comprise literally thousands of individual components, among which are instant components A, B, and C, millions of possibilities of combining these components exist. Applicants aver that the likelihood of producing a claimed composition from the shotgun disclosure of this patent would be about the same as the likelihood of discovering the combination of a safe from the mere inspection of the dials thereof (*Ex parte Garvey*, 41 USPQ 583, PO Bd. of App.). There is absolutely nothing in the reference that would have motivated one skilled in the art to select these particular components when faced with the problem of developing a process for the pretreatment of textile fibers, a problem not even addressed by the Stringer (or Gosselink) reference.

Applicants have clearly taught in the description that it is essential that the instant compositions contain, in addition to component A, both components B and C, since compositions containing only A and either B or C yield inferior results. Applicants note that the examples in the specification must be considered in reaching a conclusion as to whether the claimed invention as a whole would have been obvious. See *In re Margolis*, 228 USPQ 941 (CAFC, 1986). Applicants further aver that the combination of desirable properties shown in Table II on page 12 for the compositions of inventive Examples 1, 2, 5 and 6 must be regarded as surprising and unexpected. The examiner has not disputed this.

Hence the invention as a whole of the present claims is clearly unsuggested by Stringer et al. Reconsideration and withdrawal of the rejection of claims 2-5 and 7-8 under 35 U.S.C. § 103(a) as being unpatentable over Stringer et al. is therefore respectfully solicited.

Claims 9 and 11-12, directed to a process for the pretreatment of fiber materials, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gosselink in view of Stringer. Stringer has been discussed *supra*. The second reference, Gosselink, US Patent 5,691,298, deals with esters for soil release purposes and with laundry detergents containing these esters. However, since Stringer does not disclose or even render obvious the process according to instant claim 8, it could not have been obvious from Stringer to use compositions recited in claim 8 in Gosselink's laundry process.

Furthermore, the Gosselink processes are not pretreatment processes according to the present invention, namely treatments of textile fibers in the form of textile sheets before dyeing or other finishing operations. Rather, the Gosselink "pretreatment" is obviously a process for soil release treatment of previously laundered fabrics, i.e. end products (see col. 41, line 57), where the requirements the formulations used have to meet are substantially different from the requirements in the case of pretreatment of textile fibers according to the present application.

Since none of claimed components A to D contains any ester moieties, the esters of Gosselink, even if they contained incorporated sulfonate or ethoxylated moieties, would be of no relevance whatsoever with regard to the present invention.

Only the "detergent compositions" of Gosselink (Gosselink's claims 17 to 25 and the description in column 30, line 35 up to column 31, line 21) and the "detersive surfactants" described therein need to be considered. Gosselink does not describe compositions that contain all 4 of components A to D in these passages. In neither of Gosselink's examples there are disclosed or rendered obvious such compositions. Hence Gosselink fails to heal the deficiencies of Springer.

The examiner asserts that Stringer and Gosselink suggest the same components as recited by applicants, and thus these components would be expected to have the special requirements of primary wettability and rewettability. But it is the specific combination of these components, which is found in neither Stringer or Gosselink that has these attributes, not the individual components.

Thus, this assertion is clearly based on hindsight. However, it is well established that hindsight selection from a broad shotgun type disclosure would not guide one skilled in the art to choose applicants restricted class of compositions from among the host of possible combinations so as to make said class obvious within the meaning of 35 U.S.C. § 103. See *Ex parte Strobel et al.,* 160 USPQ 352 (PTO Bd. of App., 1968), cited with approval numerous times by the CCPA and the CAFC.

Additionally, why would one skilled in the art have been *motivated* to modify the Gosselink compositions by adding the missing components according to claim 8, to obtain compositions which contain all 4 components A to D? Since the Gosselink compositions evidently serve another purpose, namely household laundry applications, whereas the compositions according to the invention have been developed for the industrial pretreatment of fiber materials in which the special requirements (primary wettability and rewettability) have to be met, as mentioned in the description and claim 8, it

appears the sole motivation to modify the Gosselink compositions by adding the missing components according to claim 8 is hindsight, which is a clearly inadequate basis for a rejection under 35 U.S.C. § 103(a).

Reconsideration and withdrawal of all grounds of rejection of claims 2-5, 7-9 and 11-12 is respectfully solicited in light of the remarks *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 2-5, 7-9 and 11-13 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,

Kevin T. Mansfield

Ciba Specialty Chemicals Corporation
540 White Plains Road
Tarrytown, New York 10591
(914) 785-7127
KTM\22108A4

Kevin T. Mansfield
Agent for Applicants
Reg. No. 31,635